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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,001	11/29/2001	Jack D. Taylor	KCX-387 (15828)	3912

7590

04/08/2004

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EXAMINER

VO, HAI

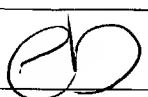
ART UNIT

PAPER NUMBER

1771

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,001	Applicant(s) TAYLOR, JACK D.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-19, 41-46, 58 and 59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19, 41-46, 58 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10-19, 58 and 59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaneko et al (US 5,445,862) substantially as set forth in the office action mailed on 10/31/2003. The art rejections have been maintained for the following reasons. The examiner absolutely agrees that the ethylene alpha-olefin copolymer is a necessary and primary ingredient of the film disclosed in Kaneko as argued by Applicant. However, the “consisting essentially of” language of claim 1 does not exclude an embodiment where the elastic film is formed from an ethylene alpha-olefin copolymer in combination with a thermoplastic polyurethane elastomer, and a filler. Further, it appears that nothing in Applicant’s specification discloses or suggests the inclusion of the ethylene alpha-olefin copolymer in the elastic film affects the novel or basic characteristics of Applicants’ invention. The mere

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absence of the ethylene alpha-olefin copolymer in Applicant's specification is not basis for an exclusion. Therefore, Applicant ~~bears~~⁴ the burden in establishing that non-recited components materially change the characteristics of Applicants' invention (MPEP 2112; *In re Delajarte* 143 USPQ 256) in order to overcome anticipation or the finding of obviousness. Accordingly, the language "consisting essentially of" is treated as "comprising" until Applicants provide the evidence in establishing that non-recited components materially change the characteristics of Applicants' invention.

Applicant argues that the term "comprising" at the beginning of the claim allows for the inclusion of other ingredients into the film such as a stabilizer but does not allow for the present of other elastic polymer film materials such as an ethylene alpha-olefin copolymer. The arguments are not found persuasive. It appears that the stabilizer as a second filler is included in the claim. The new question is raised why a second elastic polymer film material such as an ethylene alpha-olefin copolymer is not included in the claim. Accordingly, the art rejections over Kaneko are thus maintained.

4. Claims 41, 42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al (US 5,445,862) in view of Vander Wielen et al (US 4,720,415) substantially as set forth in the office action mailed on 10/31/03. The same reasons set forth in the paragraph no 3. are believed to be pertinent.
5. Claims 41, 43, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al (US 5,445,862) in view of Morman (US

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5,336,545) substantially as set forth in the office action mailed on 10/31/2003.

The same reasons set forth in the paragraph no. 3. are believed to be pertinent.

6. Claims 1-4, 7, 8, 10-13, and 41 are rejected under 35 U.S.C. 102(e) as anticipated by Ying et al (US 6,245,401) substantially as set forth in the office action mailed on 10/31/2003. Applicant argues that Ying does not disclose a polyurethane elastomer film containing a filler. The examiner disagrees because Ying disclose the second segment 14 comprises a filled polymeric film (column 10, lines 20-30). Applicant argues that the polyurethane films are described as being elastic, breathable but "non-porous", therefore claim 1 is patentable over Ying. The arguments are not found persuasive for patentability. First, The present amendment does not require the polyurethane film being porous. Secondly, Ying does disclose the second segment 14 is either microporous or non-microporous (column 10, lines 18-25). Accordingly, Ying anticipates the claimed subject matter.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

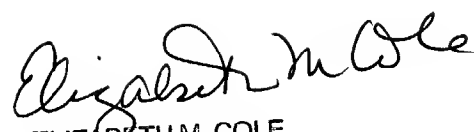
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

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ELIZABETH M. COLE
PRIMARY EXAMINER